



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,672	12/31/2003	William C. Hiscox	217604222003	1671

7590  
William C Hiscox  
PO Box 1228  
Pullman, WA 99163

EXAMINER
----------

CHOI, FRANK I

ART UNIT	PAPER NUMBER
----------	--------------

1616

MAIL DATE	DELIVERY MODE
-----------	---------------

07/22/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/707,672	<b>Applicant(s)</b> HISCOX, WILLIAM C.	
	<b>Examiner</b> FRANK I. CHOI	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2009 and 04 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Objections***

Claim 19 is objected to because of the following informalities: "A protein" should be "a protein". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention in that the examples in the specification do not appear to show conclusive evidence of synergistic activity and do not show that the combination has no objectionable odor to humans or is a non-stinky lure.

#### ***The nature of the invention:***

The invention is directed to a synergistic combination for attracting flies and other insects having no objectionable odor to humans comprising trimethylamine presented as a vapor at air concentrations higher than 1 part per billion (ppb), but not exceeding 5 parts per million (ppm), butyric acid presented as vapor at air concentration higher than 10 ppb but not exceeding 20 ppm, Z-9-tricosene and a protein based food or a non-stinky lure for attracting insects which comprises an amine, an alkylamine, an aryl amine, or an ammonia, presented in air concentrations between 1 ppb and 5 ppm, a carboxylic acid presented in air concentration

Art Unit: 1616

between 10 ppb and 20 ppb, a long chain Z-alkene or Z-alkane or an oxide of a long chain z-alkene and protein compound.

*The state of the prior art and the predictability or lack thereof in the art:*

The prior art does not appear to disclose or suggest the above invention. As such, predictability in the art appears to be low.

*The amount of direction or guidance present and the presence or absence of working examples:*

The specification provides working examples purporting to show synergy but the examples do not provide any indication as to the concentration of trimethylamine and butyric acid in the air. Further, only egg powder or pork liver is tested but the amount used is not disclosed and only three types of protein are disclosed in the specification, egg powder and chicken and pork liver. Also, the examples do not appear to provide evidence that the combinations would have no objectionable odor to humans or are non-stinky. The examples do not appear to show evidence of synergistic activity in that in Table 2 the combination of TMA/Z-9/egg only showed 33% which is well within the 44% of TMA/Z-9 + egg (individual results, Table 1) and Pork liver/TMA/Z-9 only showed 27% which is well within the 46% of pork liver/Z-9 + egg (individual results, Table 2). Further, the Specification indicates that granulated egg was far less effective than powdered egg (30% versus 70%, respectively) and that pork liver was found to be more pungent than egg powder and found to have a somewhat objectionable smell. Furthermore, in Table 3, acetic acid was shown to have less than additive effect when combined with TMA/Z-9. Also, the specification discloses that at higher concentrations that trimethylamine and butyric acid can become repellant to both flies and humans but no disclosure

Art Unit: 1616

is presented as to what levels of other amines and carboxylic acids would be become repellant to insects or humans. Finally, the Specification indicates that odor detection, recognition and revulsion thresholds are highly subjective and dependent on age of the subject tester, gender and other factors (paragraph 0020).

*The breadth of the claims and the quantity of experimentation needed:*

The claims are broad in that they claim a non-objectionable odor or non-stinky attractant for any insect with trimethylamine or other amine and butyric or other carboxylic acid at the claimed air concentrations in combination with Z-9-tricosene or a long chain Z-alkene or Z-alkane or an oxide of a long chain z-alkene and a protein. As such, in light of the above, including unpredictability and subjectiveness of a human's ability to and response to a given smell and the unpredictable differing effects of a given compound on the attractancy or repellency of a given insect, one of ordinary skill in the art would be required to do undue experimentation in order to determine what combinations of the active components and physical appearance (powder, granular, liquid), amounts, air concentrations would be effective in attracting a given insect while having no objectionable odor or being non-stinky.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 1616

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is 571-273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (571)272-0610. Examiner maintains a compressed schedule and may be reached Monday, Tuesday, Wednesday and Thursday, 6:00 am – 4:30 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Johann R. Richter, can be reached at (571)272-0646. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Frank Choi  
Patent Examiner  
Technology Center 1600  
July 22, 2009

/Johann R. Richter/

Supervisory Patent Examiner, Art Unit 1616